

Serial No. 10/053,613

Amendment Dated: December 28, 2005

Reply to Office Action Mailed: September 30, 2005

Attorney Docket No. 010482.50862US

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-6 and 8-13 are now pending, wherein claims 1 and 2 have been amended, claim 7 has been canceled and claims 8-13 have been added.

Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of alleged Applicants' Admitted Prior Art (AAPA), U.S. Patent Application Publication No. 2005/0097604 to Shintani et al. ("Shintani"), U.S. Patent No. 6,084,643 to Kishtaka et al. ("Kishtaka") and U.S. Patent No. 6,249,320 to Schneidewend et al. ("Schneidewend"). This ground of rejection is respectfully traversed.

The combination of AAPA, Shintani, Kishtaka and Schneidewend does not render Applicants' claim 1 unpatentable because even if one of ordinary skill in the art would have been motivated to combine these documents, the combination would not disclose or suggest all of the elements of Applicants' claim 1. Specifically, the aforementioned combination would not disclose or suggest the on-screen display output circuit or the particular assignment of keys on an input device recited in Applicants' claim 1.

Regarding the on-screen display output circuit, Applicants' claim 1 recites that this circuit "provides a matrix display of channel information, wherein different main channels are listed across rows of the matrix and sub-channels are listed in a same column of the matrix as a corresponding main channel."

Figure 5 of AAPA illustrates a configuration of sub-channels where the *same* main channel is listed along a row and corresponding sub-channels are listed along a column. In Figure 5, the *same main channel* is listed along a row because the configuration provides programs for a number of different time periods, and the time periods advance across different columns. However, AAPA does not disclose or suggest listing *different main channels* across *rows* of a matrix display of channel information as recited in Applicants' claim 1.

Shintani discloses an electronic program guide in which *different channels* are listed along the *same column* of the guide, and the rows of the guide include different programs for different time periods corresponding to the particular channel. (Figures 1A, 2B and 2C). However, Shintani does not even discuss main channels and sub-channels. Accordingly, Shintani does not disclose or suggest listing *different main channels* across *rows* of a matrix display of channel information as recited in Applicants' claim 1.

Schneidewend discloses an electronic program guide in which the *major channels* are listed *in the same column* and the *minor channels* are listed *in the*

same column. The electronic program guide includes different programs for different time periods corresponding to the particular major or minor channel. (Figures 12 and 13). When minor channels for a particular major channel are displayed in the electronic program guide, the major channel is listed in a first column and the corresponding minor channels are listed in a second column. However, Schneidewend does not disclose or suggest listing *different main channels* across *rows* of a matrix display of channel information as recited in Applicants' claim 1.

In view of the disclosure of AAPA, Shintani and Schneidewend that *different channels* are to be listed *in the same column* and different programs for a particular channel are to be listed in different columns of the row corresponding to the channel, the combination of AAPA, Shintani and Schneidewend would at most disclose or suggest listing *different channels in the same column*, and listing different programs for a particular channel in a row corresponding to the particular channel. However, such a listing of channels is not the same as listing *different main channels across rows* of a matrix display of channel information as recited in Applicants' claim 1.

The Office Action relies upon Kishtaka only for the disclosure of up, down, left and right keys, and not for any disclosure of the particular matrix display recited in Applicants' claim 1. Accordingly, because AAPA, Shintani,

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Schneidewend and Kishtaka all do not disclose or suggest the matrix display of Applicants' claim 1, even if one skilled in the art would have been motivated to combine these documents, such a combination would not disclose or suggest the assignment of right and left keys for main channel switch-over recited in Applicants' claim 1. Instead, in view of the disclosure in AAPA, Shintani and Schneidewend of listing different programs for a particular channel in different columns of a particular row, the right and left keys disclosed by Kishtaka would be assigned for a program selection and *not for main channel switch-over* as recited in Applicants' claim 1.

In addition to the lack of disclosure or suggestion of all of the elements of Applicants' claim 1, it appears that the rejection is based upon an improper application of the law of obviousness under 35 U.S.C. § 103. Application of the law of obviousness under 35 U.S.C. § 103 requires that the claimed invention must be considered as a whole. (M.P.E.P. § 2141). Accordingly, "the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (M.P.E.P. § 2141.02 citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983)).

In rejecting Applicants' claim 1, the Office Action cites to the configuration of the same main channel in different columns in Figure 5 of AAPA and

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concludes that “the question of patentability is whether including more than one main channel (different main channels as claimed) would be allowable over the art of record.” By limiting the patentability analysis of Applicants’ claim 1 merely to the listing of the different main channels across rows of a matrix, the Office Action is not appreciating the claimed invention as a whole, and in particular, the arrangement of the matrix display and key assignments recited in Applicants’ claim 1. Instead, it appears that the rejection is based upon a distillation of Applicants’ claimed invention “down to the ‘gist’ or ‘thrust’ of [the] invention [thereby disregarding] the requirement of analyzing the subject matter ‘as a whole.’” (M.P.E.P. § 2141.02 citing *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).

It also appears that the rejection has not considered the references as a whole as required when applying 35 U.S.C. § 103. (M.P.E.P. § 2141). AAPA, Shintani and Schneidewend all disclose *listing different channels in the same column*, and there is absolutely no disclosure of listing *different main channels across rows* as recited in Applicants’ claim 1. Recognizing this lack of disclosure in AAPA, Shintani and Schneidewend, the Office Action hypothesizes on how these disclosures may be modified to arrive at Applicants’ claim 1. For example, the Office Action hypothesizes that “if there were more channels per row [in a menu], the left/right keys in addition to the up/down keys would also be used.” However, in view of the lack of disclosure in AAPA, Shintani and Schneidewend

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of listing different main channels across a row, such a hypothesis appears to be more of an attempt at improper hindsight reconstruction in order to achieve all of the elements of Applicants' claim 1, instead of a consideration of what the combination of AAPA, Shintani and Schneidewend as a whole would have disclosed or suggested to one skilled in the art.

Because the combination of AAPA, Shintani, Schneidewend and Kishtaka does not disclose or suggest all of the elements of Applicants' claim 1, and the rejection of Applicants' claim 1 is based on an improper application of the law of obviousness under 35 U.S.C. § 103, it is respectfully submitted that the rejection of Applicants' claim 1 is improper and should be withdrawn.

Claim 2 recites similar elements to those discussed above in connection with claim 1, and accordingly, is patentably distinguishable over the combination of AAPA, Shintani, Schneidewend and Kishtaka for similar reasons to those discussed above with regard to Applicants' claim 1. Claims 3-5 depend from claim 2; and are patentably distinguishable over the combination of AAPA, Shintani, Schneidewend and Kishtaka at least by virtue of their dependency.

Claim 6 recites a method with similar elements to those discussed above with regard to Applicants' claim 1, and accordingly is patentably distinguishable over the combination of AAPA, Shintani, Schneidewend and Kishtaka for similar reasons to those discussed above with regard to Applicants' claim 1.

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For at least those reasons stated above, it is respectfully requested that the rejection of Applicants' claim 1-7 for obviousness in view of the combination of AAPA, Shintani, Schneidewend and Kishtaka be withdrawn.

New claims 8-13 variously depend from Applicants' claims 1 and 6, and are, therefore patentably distinguishable over the combination of AAPA, Shintani, Schneidewend and Kishtaka for at least those reasons stated above with regard to Applicants' claims 1 and 6.

All outstanding rejections having been addressed, it is respectfully submitted that the application is in immediate condition for allowance. Notice to this effect is earnestly solicited. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

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If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #010482.50862).

Respectfully submitted,

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Stephen W. Palan
Registration No. 43,420

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
SWP
#2675743v1